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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,341	01/27/2004	Gary Karlin Michelson	101.0036-02000	1065
22882	7590	06/29/2005	EXAMINER	
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,341

Applicant(s)

MICHELSON, GARY KARLIN

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-29-05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Upon reconsideration, the final rejection mailed Feb. 23, 2005 is hereby withdrawn.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the claimed "lock" is in light of the specification, particularly since the carrier is slidable rather than fixed to the shaft.

Claims 4, 5, 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the following limitations: the storage area increases in cross sectional area (claim 4), the tubular member includes a second opening (claim 5), the carrier member is configured to hold cut pieces of bone (claim 11), the tubular member comprises plastic material (claim 14). As to claims 4 and 5, although the original specification indicates that the storage area of member 50 increases in cross sectional area (page 12, lines 6-19) and has a second opening (page 12, lines

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26-28), it fails to indicate that the claimed tubular member (i.e. straw 90) has these features. As to claim 11, the original specification indicates that the claimed tubular member (i.e. straw 90) rather than carrier member holds cut pieces of bone (page 13, lines 23-24). As to claim 14, although the original specification indicates that the member 50 can be made of plastic material (page 13, lines 2-5), it fails to indicate that the claimed tubular member (i.e. straw 90) is made of plastic material (page 14, lines 9-11).

Claims 1-3 and 5-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wright (4,777,948). Wright discloses shaft 38, footplate (at shoulder 42), carrier member 12, tubular member 28, the shaft 38 being in slidable relationship with carrier member 12 without passing through the tubular member 28 (when the removable tubular member is removed from the rest of the assembly as indicated in col. 3, lines 6-24) and mechanism (at 14, 56) for providing reciprocal motion of carrier member 12 and shaft 38 relative to one another. Alternatively, it would have been obvious that the shaft 38 is in slidable relationship with carrier member 12 without passing through the tubular member 28 when the removable tubular member is removed from the rest of

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the assembly since the shaft 38 can still slide relative to carrier member 12 when tubular member 28 is removed therefrom.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (4,777,948). As to claim 4, Wright fails to show the storage area increasing in cross sectional area from the leading end to the trailing end. However, it is old and well known in this art to so shape storage areas in order to obtain the advantage of providing a larger area for storage of the cut material. It would have been obvious to so shape the Wright storage area so that it too would have this advantage. As to claim 14, Bent and Wright fail to show tubular cutting member comprising a plastic material. However, it is old and well known in this art to use plastic as the material for a cutting member in order to obtain the advantage of making the device low in cost. It would have been obvious to use plastic as the material for the tubular cutting member incorporated into the Bent instrument so that it too would have this advantage. The above well known in the art statements are taken to be admitted prior art because applicant failed to traverse the examiner's assertions (M.P.E.P. 2144.03).

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
6/7/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731